

REMARKS

In the November, 29, 2004 Office Action, the Examiner allowed claims 45-91. By this amendment, claims 1, 11, 25, 34 and 40, constituting all of the remaining independent claims, have been amended. No new matter has been added. Accordingly, claims 1-91 are pending.

On page 2 of the November 29, 2004 Office Action, the Examiner objected to the Figures 8 and 10 of the Application under 37 C.F.R. § 1.21(d). Submitted herewith are replacement pages 5 and 6 to the Application, with Figures 8 and 10 corrected accordingly. Applicant respectfully submits that the corrected Figures 8 and 10 are now in compliance with 37 C.F.R. § 1.21(d).

Remarks Concerning Rejections Under 35 U.S.C. § 103

In the November 29, 2004 Office Action, the Examiner did not reject any of the claims of the application under 35 U.S.C. § 102. Applicant thus turns to the rejections under 35 U.S.C. § 103.

On page 2 of the November 29, 2004 Office Action, the Examiner rejected claims 1-44 as being unpatentable over U.S. Patent No. 4,614,900 to Young ("Young") in view of U.S. Patent No. 6,678,589 B2 to Robertson et al. ("Robertson"), and in further view of HMC 1055, a document submitted by Applicant in Applicant's Information Disclosure Statement. In view of the claim amendments made herein, Applicant respectfully traverses that rejection.

The independent claims of the present application (1, 11, 25, 34 and 40) are directed collectively to a trolling motor, control system for the same, and a method for controlling a trolling motor. While each of the independent claims is directed to a different aspect of the invention, all of the claims include both a transmitter for transmitting signals corresponding to a change in the heading of a boat, and a receiver for causing a change in the steering direction of the motor for achieving the new heading.

None of the references cited by the Examiner, either alone or in combination, disclose the steps of transmitting signals corresponding to a change in the heading of a boat and causing a change in the steering direction of the motor for achieving the new heading. Young relates to an electric trolling motor operated remotely controlled by a hand held or foot operated energy

transmitter. However, as the Examiner observed, Young lacks a direction sensor, an electronic magnetic compass and a tilt compensator. Young allows for the remote actuation of a trolling system (col. 4, ll. 60 et seq.), but includes no element for sensing a change in the heading of a boat.

Robertson fails to cure the deficiencies of Young. Robertson relates to an anchorless boat positioning system for establishing and maintaining a boat at a selected geographic location without the use of a conventional anchor. On page 3 of the November 29, 2004 Office Action, the Examiner equated the "direction sensor" of the present application with the system disclosed in Robertson for determining a position for a boat to maintain. That system involves determining a position, and then controlling the thrust of a motor to maintain that said position (col. 5, ll. 7-22). Robertson, however, includes no mention of determining a *change* in a *heading* of a boat. The present invention is directed to a system for directing a boat in a new *heading*, whereas Robertson is directed to a system for directing a boat to *maintain its position*. Neither Young nor Robertson includes any such disclosure or suggests any such innovation.

HMC 1055 fails to cure the deficiencies of Young or Robertson. HMC 1055 discloses a tilt compensator, but includes no disclosure of determining a change in the heading of a boat, and effecting that change in heading by controlling a trolling motor. In fact, HMC 1055 does not disclose a trolling motor embodiment at all.

Applicant therefore respectfully submits that the combined teachings of Young, Robertson and HMC 1055 do not disclose the elements of the present invention. Specifically, none of those references, either alone or in combination, discloses the steps of determining a change in the heading of a boat and actuating a trolling motor to achieve that change in heading.

In addition to failing to disclose each of the limitations of the independent claims of the present invention, the combination of Young, Robertson and HMC 1055 is improper because there is no motivation or incentive in the prior art to combine those references in the manner suggested by the Examiner (In re Napier (Fed. Cir. 1995), 55 F.3d 610, 613). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art (In re Fine (Fed. Cir. 1988), 837 F.2d 1071, 5 USPQ2d 1596; In re Jones (Fed. Cir. 1992), 958 F.2d 347, 21 USPQ2d 1941).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure (In re Vaeck (Fed. Cir. 1991), 947 F.2d 488, 20 USPQ2d 1438). The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness (MPEP § 2142). In the present case, the Examiner has failed to meet that burden. Instead, the Examiner has simply concluded one skilled in the art would make the suggested modification. That is insufficient.

Young and Robertson are from the trolling motor control system field. HMC 1055, on the other hand, is from the tilt compensator chip field. On page 3 of the November 29, 2004 Office Action, the Examiner concluded that it would have been obvious to combine the teachings of Young and Robertson with HMC 1055 for "improved control." However, none of the cited references, nor any other prior art in those fields, includes any suggestion that the system of Young or Robertson would be helpful, advantageous or operative if combined with HMC 1055 as suggested by the Examiner. As a result, there is no showing of any motivation to combine the references.

Instead, it appears that the Examiner used hindsight in making the suggested combination. However, hindsight combination of references, using the present invention as a roadmap, is improper. It is well recognized that the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art in an attempt to render the claimed invention obvious (In re Fritch (Fed. Cir. 1992), 972 F.2d 1260, 1266).

The Examiner also rejected the dependent claims as being unpatentable over the combined teachings of Young, Robertson and HMC 1055, namely claims 2-10, 12-24, 25-33, 35-39 and 41-44. Because the independent claims are all distinguishable over Young, Robertson and HMC 1055 for the reasons mentioned above, and further because there is no motivation to

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combine those patents, the dependent claims of the application are therefore distinguished over those references as well.

Applicants therefore request that the § 103 rejected based on the Young, Robertson and HMC 1055 references be withdrawn.

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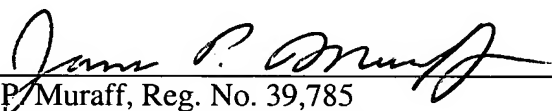
CONCLUSION

In light of the remarks made herein, Applicant respectfully submits that claims 1-91 are in condition for allowance. Applicant respectfully requests that the Examiner withdraw the rejections and allow the claims to issue. If it may be of assistance to contact the undersigned Attorney regarding the present invention, the Examiner is invited to do so. The Commissioner is hereby authorized to charge Deposit Account No. 23-0280 in connection with any fees associated herewith.

Respectfully submitted,

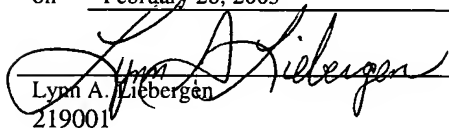
Dated: February 28, 2005

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CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service, with first class postage prepaid, in an envelope addressed to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 28, 2005


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